

A2 consisting of an acid anhydride group, a carboxyl group, a hydroxyl group, an epoxy group and an amino group.

Please amend Claim 11 as follows:

A3
Sub C1 11. (Amended) A composition for a polishing pad which comprises a water-insoluble matrix material containing a crosslinked polymer and a water-soluble particle dispersed in the water-insoluble matrix material, wherein said water-soluble particle is provided with an outer shell for inhibiting moisture absorption in at least a part of the outermost part.

Please add the following new Claims 17-19:

A4
Sub C1 17. (New) A composition for a polishing pad which comprises a water-insoluble matrix material containing a crosslinked polymer and an organic water-soluble particle comprising at least one selected from the group consisting of dextrin, cyclodextrin, mannitol, lactose, hydroxypropylcellulose, methylcellulose, starch, protein, polyvinyl alcohol, polyvinyl pyrrolidone, polyacrylic acid, polyethylene oxide, water-soluble photosensitive resin, sulfonated polyisoprene and sulfonated polyisoprene copolymer, dispersed in the water-insoluble matrix material.

18. (New) The composition for a polishing pad according to claim 17, wherein the elongation remaining after breaking is 100% or less when a test piece comprising the water-insoluble matrix material is broken at 80°C.

19. (New) The composition for a polishing pad according to claim 17, wherein said water-insoluble matrix material is modified with at least one selected from the group consisting of an acid anhydride group, a carboxyl group, a hydroxyl group, an epoxy group and an amino group.

DISCUSSION OF THE AMENDMENT

Claim 1 has been amended by incorporating the subject matter of Claim 2 therein; Claim 2 has been canceled. Claim 3 has been amended to depend on Claim 1. Claim 11 has been amended into independent form. Finally, new Claims 17-19 have been added. Claim 17 is based on the combination of Claim 1 and that part of Claim 4 drawn to an organic water-soluble particle. Claims 18 and 19 are analogous to original Claims 2 and 3, respectively.

No new matter has been added by the above amendment. Claims 1-19 are now pending in the application. Claims 1-13 and 17-19 are active; Claims 14-16 stand withdrawn from consideration.

ELECTION

Restriction has been required under 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 1-13, drawn to a composition, classified in class 524, subclass 47.
- II. Claims 14-16, drawn to a polishing pad, classified in class 401, subclass 261.

Applicants have elected **with traverse** the invention of Group I, i.e., Claims 1-13.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct (MPEP §803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (MPEP §803). Applicants respectfully traverse the Restriction Requirement on the ground that the Examiner has not carried the burden of providing any material reasons and/or examples to support the conclusion that the claims of the restricted groups are patentably distinct.

The Examiner has categorized the relationship between the inventions of Group I and Groups II, as mutually exclusive species in intermediate-final product relationship. The Examiner must prove that the intermediate product is useful to make other than the final product (MPEP 806.04(b)), and the species are patentably distinct (MPEP 806.04(h)).

In reply, the Examiner is incorrect. Groups II and I are drawn to a combination and subcombination, respectively. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability and (2) the subcombination can be shown to have utility either by itself or in other and different relations. MPEP 806.05(c). The Examiner has not made such a showing. Rather, the Examiner asserts that "the intermediate product" of Group I "is deemed to be useful as a material for coating by spraying." It is not clear what this means. Nevertheless, nothing has been cited to back it up.

The Examiner's attention is drawn to the following from MPEP §803:

If the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. (emphasis added).

Search and examination of the entire application would not appear to impose a serious burden herein.

In view of the above, it is respectfully requested that the Restriction Requirement be withdrawn, and that all claims of the application be examined.

REMARKS

The rejection of Claims 1 and 3 under 35 U.S.C. § 102(b) as anticipated by a number